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### **REMARKS**

Claims 1-5 and 66-69 and are pending with claim 1 being independent. Claim 1 has been amended to correct an informality identified in a previous office action. Claims 66-69 have been added. No new matter has been added. For at least the following reasons, Applicants respectfully request reconsideration and allowance of this application.

### **Final Rejection Improper**

Applicants respectfully submit that the Office Action of March 13, 2006 was improperly made final. According to M.P.E.P. § 706.07(a) a "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims." The new grounds of rejection set forth in the Office Action was not necessitated by an amendment of the claims by Applicants. Rather, the new ground of rejection was necessitated by the decision in the Pre-Appeal Brief Conference to reopen prosecution on the merits. Accordingly, the finality of the Office Action is improper and should be withdrawn, and the above amendment should be entered.

### **Rejection of Claims 1-4 Under 35 U.S.C. § 103(a)**

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being obvious over Lee (U.S. Pat. No. 6,272,961) in view of Jameson (U.S. Pat. No. 3,777,792), Weissman (U.S. Pat. No. 4,885,965), Mayfield (U.S. Pat. No. 5,063,806), Rueb (U.S. Pat. No. 5,577,428), Welch (U.S. Pat. No. 5,906,538), Greenland (U.S. Pat. No. 6,080,041), and Gorgol (U.S. Pat. No. 6,273,081). For at least the following reasons, Applicants respectfully request withdrawal of this rejection.

Claim 1 relates to a saw and recites, among other things, "a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." As acknowledged on page 2 of the Office Action, Lee fails to describe at least these features of claim 1. Rather, Lee describes a switch located on controlling head 45 that moves with motor 42 as it pivots.

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For this feature, the Office Action instead relies upon the teachings of Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol, which according to the Office Action "disclose saws with switches in various locations." However, as admitted in the Office Action, "the specific location of the switch that Applicant is claiming is not specifically taught" by any of these references. Instead, the Office Action relies upon these references as "cumulative evidence that a switch can be placed almost anywhere on a saw." The Office Action asserts as motivation that "the location of the switch would have been an obvious matter of choice dependent on the suitability of that location for whatever desired reason, such as dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product." In response to Applicants' previous arguments, the Office Action argues that "the criticality of the switch is not presented in the original disclosure," and that the differences between Applicants' device and the prior art has not been claimed.

This rejection is improper for at least the following reasons. First, none of these secondary references, taken alone or cumulatively, provide the motivation or suggestion relied upon by the Office Action to make the proposed modification to the switch location in Lee. Second, the purported motivation set forth in the Office Action is not based on the teachings of the prior art, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved. Third, the response to Applicants' arguments ignores the disclosure in the specification and drawings, as well as the plain language of the claims. These reasons are discussed in turn.

#### **1. No Motivation or Suggestion to Modify In Secondary References**

The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." M.P.E.P. § 2144.04(IV)(C) (quoting Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)). However, as discussed below, the secondary references, alone or in combination, provide no suggestion to make the proposed modification to Lee. Indeed, some of the secondary references teach away from the proposed modification.

Jameson relates to a mortise cutting machine that automatically feeds and cuts bedframes. The machine includes a feed table 11, a rotary work fence 12, and a saw assembly 13. The saw

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assembly includes a saw 30 driven by a motor 37. Jameson is silent as to a switch that is electrically connected to the motor assembly, as recited in claim 1. By failing to show any switch whatsoever, Jameson cannot provide any motivation or suggestion to change the location of the switch in Lee.

Weissman relates to a rotary table saw used for cutting sections of dental models. The saw includes a base 12 that houses a motor 41, a saw blade 50 and that includes a switch 24. Coupled to the base 12 is a work table that moves up and down relative to the base to hide and expose the saw blade. The motor 41 and the saw blade 50 do not move. Thus, the switch of Weissman is not "disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary," as recited in claim 1. Rather, the switch of Weissman is disposed on a base that remains stationary and is not pivoted relative to the motor and saw blade. Because Weissman shows a switch coupled to a motor and saw assembly that remains stationary, Weissman provides no motivation or suggestion to change the position of the switch in Lee, which is coupled to a pivoting motor.

Mayfield relates to a radial arm saw with a work table 12, a support arm assembly 18, and a carriage 24 that supports a saw blade 30, and an anti-kick device 36. The carriage 24 is pivotable about cylindrical portion 20 and also enables the saw blade to be moved longitudinally. The radial arm saw includes three switches 54, 84, and 80 that may arguably correspond to the claimed switch. However, each of these moves with the carriage 24, rather than remaining stationary, as required by the claim. Switch 54 turns on and off the kick preventing means and is located directly on the handle of the carriage. Rheostat 84 adjusts the speed of the motor driving kick preventing means and is coupled with the carriage 24 to pivot with the carriage about cylindrical portion 20. Switch 80 turns on and off a clutch and is positioned on the carriage and pivots with the carriage. Thus, Mayfield provides no motivation or suggestion to make the switch of Lee stationary. To the contrary, Mayfield teaches away from the proposed modification to Lee.

Rueb relates to an apparatus 10 for holding a portable circular saw 85 and for holding and guiding a workpiece across the saw 85. Because Rueb describes the switch as being on the

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portable saw 85 itself, Rueb provides no motivation or suggestion for moving the switch of the saw of Lee from the motor of the saw to another location on the frame assembly.

Welch relates to a cutting apparatus 10 for cutting a work piece 24. The cutting apparatus 10 includes a motor unit 11 mounted to a mounting plate 34, which is attached to a planar member 17 by hinges 40. A bolt 41 extends through a lift 42 which extends underneath the mounting plate 34. As the bolt 41 is rotated clockwise, the lift 42 rises upwardly, along the bolt 41, and elevates the mounting plate 34, and selectively elevating an abrasive wheel 12 to a desired height. The abrasive wheel 12 extends in a substantially vertical plane perpendicular to a longitudinal axis of the arbor 13 and motor unit 11. A plurality of guide rails 14, 15 and 16 are mounted on the top surface 18 of the planar member 17, parallel the abrasive wheel 12. A switch (not labeled) is mounted to the planar member 17 and electrically connected to the motor unit 11.

The motor unit 11 of Welch (which arguably corresponds to the claimed motor assembly) does not pivot "about an axis substantially parallel to the longitudinal axis" of the guide rail 14 (which arguably corresponds to the claimed first rail) in order to allow the saw assembly to perform bevel cuts. Rather, the motor unit 11 of Welch pivots on hinges 40 to enable adjustment of the height of the abrasive wheel 12. Thus, Welch does not provide motivation or suggestion to move the switch of Lee to so that the switch is "disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary," as recited in claim 1, as moving the switch as taught by Welch would not achieve the claimed invention.

Greenland relates to a saw 10 with a rectangular frame 12, a sliding table 14, and a pivoting support arm 16 that holds a motor assembly 18 above the table. The motor assembly 18 includes a cutting blade 20 mounted to an electric motor 22 within a housing 24. The motor assembly includes a lever 28 mounted to a power switch 30 to automatically turn on the motor as a tile is moved toward the motor assembly 18. Thus, the switch 30 pivots with the motor housing 24. Thus, Greenland fails to describe or suggest modifying the switch of Lee to be "disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary," as recited in claim 1. To the contrary Greenland teaches

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away from the proposed modification of Lee by teaching a switch 30 that moves with the motor housing 24.

Gorgol relates to a gasoline powered masonry saw 10 that includes a gasoline engine 18, an arbor 20, a cutting blade 22, a dust collection pan 24, and a cutting tray 26, supported on a frame 12 with vibration dampening material. Gorgol is silent as to a switch that is electrically connected to the motor assembly, as recited in claim 1. By failing to show any switch whatsoever, Gorgol provides no motivation or suggestion to change the location of the switch in Lee.

Thus, none of the secondary references cited in the Office Action, taken in any combination, provide a motivation or suggestion to modify the location of the switch of Lee to be "disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary," as recited in claim 1.

**2. Purported Suggestion or Motivation Not Based on Prior Art, Knowledge of One of Ordinary Skill, or Nature of Problem**

The Office Action proposes a motivation or suggestion as follows: "the location of the switch would have been an obvious matter of choice dependent on the suitability of that location for whatever desired reason, such as dexterity, eye coordination, or standing position of the operator, ease of manufacturing, or position of the work piece and/or product." Although the suggestion or motivation to modify a reference need not be explicit, the motivation or suggestion must be drawn from "the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kahn, No. 04-1616 (Fed. Cir. March 22, 2006).

The purported suggestion or motivation set forth in the Office Action is not drawn from the teachings of the prior art, the knowledge of one of ordinary skill in the art, or the nature of the problem to be solved. First, as explained above in section 1 above, this motivation or suggestion is not apparent in the prior art. Second, the Office Action provides no evidence of the knowledge of one of ordinary skill in the art that would motivate the proposed modification of

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Lee. Third, the Office Action fails to set forth the nature of the problem to be solved in a way that would motivate the proposed modification of Lee.

Rather, having the switch remain stationary, as recited in claim 1, provides significant advantages over the moveable switch shown in Lee. For example, the stationary switch allows the user of the saw to know the location of the switch at all times during operation of the device. This provides a safety feature when the user must quickly shut off the device during use. Nothing in the prior art, the knowledge of one of ordinary skill, or the nature of the problem to be solved suggests modifying Lee to achieve this result. Instead, the proposed motivation or suggestion appears to be based on impermissible hindsight.

**C. Response to Applicants' Arguments Ignore Specification, Drawings, and Claims**

In response to Applicants' previous arguments, the Office Action asserts that "the criticality of the switch is not presented in the original disclosure," and that the differences between Applicants' device and the prior art has not been claimed. These assertions ignore the disclosure in the specification and drawings, as well as the plain language of the claims.

First, although Applicants maintain that no single feature, including the switch position, is critical to claim 1, Applicants respectfully note that position of an embodiment of the switch 92 is disclosed at least at paragraph 00133 and Figures 1 and 13A, although other embodiments are contemplated.

Second, as discussed above and as acknowledged by the Office Action, the differences between claim 1 and the cited prior art include, at least that the prior art does not describe or suggest "a switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary," as recited in claim 1.

\* \* \*

For at least the foregoing reasons, claim 1, and its dependent claims 2-4, are patentable over Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Greenland, and Gorgol, or any combination thereof.

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**Rejection of Claim 5 Under 35 U.S.C. § 103(a)**

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being obvious over Lee, as applied to claim 1 above, and further in view of Klingens (U.S. Pat. No. 2,691,398). Claim 5 depends from claim 1 and is allowable for at least the reasons discussed above with respect to claim 1. Moreover, Klingens does not remedy the deficiencies of Lee discussed above with respect to claim 1. In particular, Klingens does not describe or suggest, nor is it relied upon to show, at least the claimed "switch electrically connected to the motor assembly and disposed on the support assembly so that, when the motor assembly is pivoted about the pivot axis, the switch remains stationary." For at least these reasons, claim 5 is patentable over Lee and Klingens.

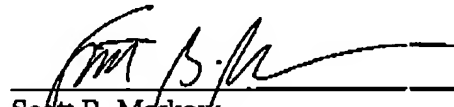
**Conclusion**

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

No fees are believed to be due. Please apply any charges or credits to deposit account 02-2548

Respectfully submitted,

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Scott B. Markow  
Reg. No. 46,899

The Black & Decker Corporation  
701 E. Joppa Road - TW199  
Towson, MD 21286  
Telephone No.: (410) 716-3606  
Facsimile No.: (410) 716-2610